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Robert Bernstein

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CARLSON, JEFFREY D

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT BERNSTEIN

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Appeal 2009-004012  
Application 09/777,098  
Technology Center 3600

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Decided: November 23, 2009

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Robert Bernstein (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-22. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM.<sup>1</sup>

## THE INVENTION

This invention is a method and apparatus for identifying potential customers for delivery of promotional materials. Specification 2:11-12.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A programmed computer method of identifying potential customers for delivery of promotional materials, such method implemented by the programmed computer to effect the following steps:

a third-party tax record database forming data files about customers where the third-party database is separate from any vendor and where the third-party database also determines a tax due on previous purchases made by customers;

a programmed central processing unit of a vendor forming a customer profile for targeting delivery

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<sup>1</sup> Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed Mar. 13, 2008) and the Examiner's Answer ("Answer," mailed May 16, 2008, corrected Jun. 19, 2008).

of the promotional materials to potential customers;

a programmed comparator of the database of the third party searching the formed files within the database and identifying customers which match the customer profile within the database of the third party; and

a programmed processor forwarding promotional materials to the identified customers.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Taricani, Jr.	US 6,347,304 B1	Feb. 12, 2002
Katz	US 2002/0077901	Jun. 20, 2002
Oytac	US 20030018613A1	Jan. 23, 2003

Provisional Application 60/221774.

Provisional Application 60/256,324.

The following rejections are before us for review:

1. Claims 9-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 1-6, 8-14, 16-20, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oytac and Taricani, Jr..
3. Claims 7, 15, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oytac, Taricani, Jr., and Katz.

## ARGUMENTS

*The rejection of claims 9-22 under §112, second as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The Examiner rejected claim 17, which recites “customer information from a plurality of independent vendors regarding their respective customers” and similarly rejected claim 9, which recites “a customer profile provided by a vendor,” because it is unclear how the recitation of where the information is from effects the scope of the claim. The Appellant merely responds by asserting that the claims are clear. Br. 7-8.

*The rejection of claims 1-6, 8-14, 16-20, and 22 under §103(a) as being unpatentable over Oytac and Taricani, Jr.*

The Appellant argues that Examiner has not established a prima facie showing that claims 1-6, 8-14, 16-20, and 22 are obvious over Oytac and Tarciaini, Jr. Br. 8-17. However, the Appellant does not dispute the Examiner’s findings regarding the Oytac and Tarciani, Jr. disclosures nor does the Appellant dispute the Examiner’s rationale that the combination of Oytac and Tarciani, Jr. would be obvious “so that additional revenues could be generated from the valuable consumer data” (Answer 6). *See* Br. 8-17.

Instead the Appellant traverses the Examiner’s conclusion of obviousness by arguing that one of ordinary skill in the art would not combine Oytac and Tarciani, Jr. because the operator in Tarciani, Jr. is acting as an agent of the revenue agency and is therefore limited by agency law. Br. 8-14. The Appellant asserts that “[i]t is fundamental to U.S.

privacy law that public entities (and their agents) cannot release private information for commercial purposes” and therefore, the combination of Oytac and Tarciani, Jr. “could not work as the Office Action asserts because the law forbids it.” Br. 9.

*The rejection of claims 7, 15, and 21 under §103(a) as being unpatentable over Oytac, Taricani, Jr., and Katz.*

The Appellant’s traverse the rejection of claims 7, 15, and 21 for the same reasons as for claims 1-6, 8-14, 16-20, and 22 above. Br. 10-11.

## ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in finding claims 9-22 indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second issue is whether the Appellant has shown that the Examiner erred in concluding that one of ordinary skill in the art would have been led by Oytac and Taricani, Jr. to the method and apparatus recited in claims 1-6, 8-14, 16-20, and 22.

The third issue is whether the Appellant has shown that the Examiner erred in concluding that one of ordinary skill in the art would have been led by Oytac, Taricani, Jr., and Katz to the method and apparatus recited in claims 7, 15, and 21.

## FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

### *The scope and content of the prior art*

1. We adopt the Examiner's finding as to the scope and content of the prior art. *See* Answer 5-7.

### *Any differences between the claimed subject matter and the prior art*

2. We adopt the Examiner's finding as to the differences between the claimed subject matter and the prior art. *See* Answer 5 and 7.

### *The level of skill in the art*

3. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of advertising. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

### *Secondary considerations*

4. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

## PRINCIPLES OF LAW

### *Definiteness*

The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

### *Obviousness*

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.



## ANALYSIS

*The rejection of claims 9-22 under §112, second as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

We find that the recitations that the information was provided by a vendor in claims 9 and 17 do not cause those claims to be indefinite. The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). We find that one of ordinary skill in the art would be ascertain the scope of these claims when read in the light of the Specification. As, the Examiner states “[a] database physically storing information is the same apparatus regardless of where the information came from or who provided the information for storage.” Answer 4.

Accordingly, we find that the Examiner has erred in rejecting independent claims 9 and 17, and claims 10-16 and 18-22, dependent thereon, under 35 U.S.C. §112, second paragraph.

*The rejection of claims 1-6, 8-14, 16-20, and 22 under §103(a) as being unpatentable over Oytac and Taricani, Jr.*

The Appellant argued claims 1-6, 8-14, 16-20, and 22 as a group (Br. 8). We select claim 1 as the representative claim for this group, and the remaining claims 2-6, 8-14, 16-20, and 22 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

First, we find that the Examiner has established a prima facie showing that one of ordinary skill in the art would have been led to combine Oytac and Tarciani, Jr. The Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415. (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 415. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417, (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532 (1976)).

We find that the combination is nothing more than the predictable use of prior art elements according to their established functions. As found by the Examiner, both Oytac and Taricani, Jr. teach collecting transaction data from sellers. Oytac uses the data to sell targeted advertising. Taricani, Jr. uses the data to calculate taxes on out of jurisdiction purchases. In the combination both would perform the same function. Further, the Examiner has reasoned, and the Appellant does not dispute, that the combination would generate additional revenue from collecting the information. Answer 6. Therefore, we find that the Examiner has established a prima facie showing of obviousness.

The Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Appellant does not dispute the Examiner's findings of fact nor the rationale asserted by the Examiner in finding the combination obvious. Instead, the Appellant cites Taricani, Jr., which states, "[when] the tax due notice indicates payment is to be paid to the network operator, the network operator essentially acts as an independent contractor for the revenue agency. . ." (Taricani, Jr. column 6, lines 49-51), and asserts that the combination would be "illegal" under the laws of agency since an agent cannot disclose private information to other parties. Br. 9. However, the Appellant provides no evidence to support this argument nor cites to any specific law of any jurisdiction. We find no evidence supporting Appellant's contentions elsewhere in the record. *See generally, In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973). However, we note that both Oytac and Taricani, Jr. describe sharing the collected transaction information with third parties. Oytac describes compiling information into their database from various agencies, including government agencies. Oytac [0019]. Tarciani, Jr. describes a compact between different jurisdictions to share purchase information. Tarciani, Jr. col. 2, lines 29-55 and col. 8, lines 32-38.

Accordingly, we find that the Appellant has not shown that the Examiner erred in rejecting claims 1-6, 8-14, and 16-20 under 35 U.S.C. §103(a) as unpatentable over Oytac, Taricani, Jr. and Katz.

*The rejection of claims 7, 15, and 21 under §103(a) as being unpatentable over Oytac, Taricani, Jr., and Katz.*

The Appellant argues against the rejection of claims 7, 15, and 21 for the same reasons used to argue against the rejection of claim 1. (Br. 10-11). Accordingly, because we found the Appellant's argument unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claims 7, 15, and 21. We find that the Appellant has not shown that the Examiner erred in rejecting claims 7, 15, and 21 under 35 U.S.C. §103(a) as unpatentable over Oytac, Taricani, Jr. and Katz.

#### CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting Claims 9-22 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

We conclude that the Appellant has not shown that the Examiner erred in rejecting:

claims 1-6, 8-14, 16-20, and 22 are under 35 U.S.C. §103(a) as unpatentable over Oytac and Taricani, Jr. and

claims 7, 15, and 21 under 35 U.S.C. §103(a) as unpatentable over Oytac, Taricani, Jr., and Katz.

DECISION

The decision of the Examiner to reject claims 1-22 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

MP

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